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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YEN-FU CHEN and JOHN W. DUNSMOIR

Appeal 2009-002510
Application 10/756,918
Technology Center 2600

Decided: January 28, 2010

Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI, and MARC S.
HOFF, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-12, 14, and 16-20, which are all of the pending claims. Claims 13 and 15 have been canceled (App. Br. 4). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (filed April 16, 2008) and the Answer (mailed May 15, 2008) for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants' Invention

Appellants' invention relates to performing handwritten character recognition based on parameters collected from strokes of the handwritten characters. Stroke start and end events are identified and stroke parameters are calculated from coordinates of the stroke start and end events. The stroke parameters are transmitted to a server concurrently with a user input of subsequent stroke. (*See generally* Spec. 4:2-9 and 20:17-28).

Claim 1 is illustrative of the invention and reads as follows:

1. A method in a data processing system for performing handwritten character recognition, the method comprising the computer implemented steps of:

responsive to user input to a pointing device entered through a computer interface, identifying a stroke start event and a stroke end event;
deriving a stroke parameter from the stroke start event and the stroke end event;

transmitting the stroke parameter to a server concurrently with user input of a subsequent stroke; and

receiving a candidate character from the server, wherein the candidate character is based on the stroke parameter.

The Examiner's Rejection

The Examiner relies on the following prior art to show unpatentability:

Kannan	US 5,329,625	Jul. 12, 1994
Ilan	US 6,023,529	Feb. 8, 2000
Bryborn	US 2003/0107558 A1	Jun. 12, 2003
Ito	US 6,694,056 B1	Feb. 17, 2004 (filed Oct. 12, 2000)

Claims 9-12 and 14 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.¹

Claims 1, 3, 4, 6-11, 14, 16, 17, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito in view of Bryborn.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito in view of Bryborn and Kannan.

Claims 5, 12, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito in view of Bryborn and Ilan.

ISSUES

The pivotal issues before us are whether Appellants have demonstrated that the Examiner erred in determining that

¹ The Examiner's statement (Ans. 4) of the grounds of rejection includes claims 13 and 15. These claims, however, have been previously canceled.

a) claims 9-12 and 14, which recite “a computer program product in a recordable-type medium...,” are directed to non-statutory subject matter, and

b) Bryborn discloses the transmitting of handwriting stroke parameters to a server concurrently with the input of subsequent strokes by a user.

FINDINGS OF FACT

The record supports the following relevant findings of fact (FF) by a preponderance of the evidence:

1. Appellants disclose (Spec. 33:5-6) that the handwriting character recognition processes of the present invention are capable of being distributed in the form of a computer readable medium of instructions. “Examples of computer readable media include recordable-type media, such as a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs,...” (Spec. 33:10-12).

2. Bryborn discloses (Fig. 5, ¶ [0078, Il. 1-7] an electronic pen 10 for recording handwritten information in which a user is required to initiate the transmission of recorded strokes to a server 5 by activating a SEND button on the electronic pen 10.

3. Bryborn also discloses (¶ [0078, Il. 7-10] an alternative stroke transmission embodiment in which the transmission is initiated automatically after a period of time.

4. Bryborn further discloses (¶ [0078, Il. 10-11] that automatic stroke transmission will also occur “when the memory 16b in the pen 10 has reached a certain degree of filling.”

PRINCIPLES OF LAW

Statutory Subject Matter

Fundamental principles, such as "laws of nature, natural phenomena, and abstract ideas," are not patent eligible. *In re Bilski*, 545 F.3d 943, 952 (Fed. Cir. 2008) ("Specifically, the Court has held that a claim is not a patent-eligible 'process' if it claims 'laws of nature, natural phenomena, [or] abstract ideas. Such fundamental principles are 'part of the storehouse of knowledge of all men . . . free to all men and reserved exclusively to none.'" (Citations omitted.)), *cert. granted*, 129 S.Ct. 2735 (U.S. June 01, 2009) (No. 08-964). The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004); and our decision in *Ex parte Curry*, 2005-0509 (BPAI 2005) (*aff'd*, Rule 36, Fed. Cir., slip op. 06-1003, June 2006).

Further, a transitory, propagating signal is not a "process, machine, manufacture, or composition of matter." Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007) *reh'g en banc denied*, 515 F.3d 1361 (Fed. Cir. 2008), *cert. denied*, 129 S.Ct. 70 (2008).

Obviousness

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

I. The 35 U.S.C. § 101 rejection of claims 9-12 and 14.

Appellants' arguments are persuasive in convincing us of error in the Examiner's stated position and, accordingly, this rejection is not sustained. The Examiner directs attention to page 33 of Appellants' Specification which discloses that "[e]xamples of computer readable media include...transmission-type media...." According to the Examiner (Ans. 21-23), the cited portion of Appellants' Specification amounts to a disclosure that the "recordable type medium" recited in claim 9 could correspond to a (disembodied) signal, which is neither a process nor a product, but an intangible form of energy, rendering the claim nonstatutory (Ans. 15-16). *See Nuijten*, 500 F.3d at 1357.

We do not agree with the Examiner's position. Appellants' Specification nowhere states that its "computer program product in a recordable-type medium" may be "embodied" as an intangible signal. The very paragraph of the Specification cited by the Examiner as evidence that Appellants contemplate that its medium may be a "signal" in fact teaches the opposite. Appellants, at page 33 of the Specification, provide several examples of the claimed "recordable-type media" in the same cited paragraph, i.e., "a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs" (FF 1). Through these examples, Appellants have provided a clear definition of the phrase "recordable-type medium" which excludes embodiments (*i.e.*, "transmission-type media,") considered nonstatutory under *Nuijten*.

II. The 35 U.S.C. § 103(a) rejection of claims 1, 3, 4, 6-11, 14, 16, 17, 19, and 20 based on the combination of Ito and Bryborn.

With respect to the Examiner's obviousness rejection of representative independent claim 1 based on the combination of Ito and Bryborn, Appellants' arguments assert a failure by the Examiner to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references.² Appellants' arguments do not attack the Examiners' basis for the proposed combination but, rather, focus on the contention that neither Ito nor Bryborn discloses the claimed feature of "transmitting the stroke parameter to a server *concurrently with user input of a subsequent stroke*." (Emphasis added).

In particular, according to Appellants (App. Br. 14-15), the Bryborn reference, relied upon by the Examiner as teaching this feature, discloses in paragraph [0047] only that pen strokes are stored in an internal memory of a writing pen until a current writing session is ended and then subsequently transmitted to a server. In further support of their position, Appellants (*id.*) direct attention to paragraph [0078], lines 2-7 of Bryborn which, according to Appellants, discloses that stroke information is transmitted separately from the input of additional strokes by requiring that a user activate a SEND button to transmit stroke information to a server (FF 2).

² Appellants argue rejected claims 1, 3, 4, 6-11, 14, 16, 17, 19, and 20 together as a group, making particular reference only to independent claim 1. See App. Br. 7-11. Accordingly, we select claim 1 as representative. See 37 C.F.R. § 41.37(c)(1)(vii).

We do not find Appellants' arguments to be persuasive of any error in the Examiner's stated position. Included in the same paragraph [0078] citation of Bryborn relied on by Appellants, is a discussion of an alternative embodiment which does not require a stroke transmission step that is separate from user input of additional strokes. At lines 7-11 of paragraph [0078], Bryborn discloses that stroke transmission to server 5 is initiated automatically after a predetermined period of time (FF 3) or when the memory in electronic pen has filled to a predetermined level (FF 4).

With the above discussion in mind, we find that an ordinarily skilled artisan would reasonably conclude, as did the Examiner (Ans. 25), that a user of Bryborn's electronic pen 10 would continue to enter additional character strokes concurrently with the automatic transmission of the recorded strokes to the server. Lending support to this conclusion is the fact that nowhere in the disclosure of Bryborn is there any indication that a user is provided a message or warning to stop entering additional strokes during the automatic recorded stroke transmission. Even further, it is noteworthy that in describing the memory fill condition for triggering automatic recorded stroke transmission, Bryborn does not indicate that the electronic pen memory be filled to capacity before automatic transmission but, rather, only that the memory be filled to a "certain degree of filling." (FF 4). In other words, it is reasonable to conclude that pen memory capacity is available in Bryborn to record additional character strokes concurrently with automatic transmission of previously recorded strokes.

For the above reasons, since it is our opinion that the Examiner has established a prima facie case of obviousness based on the teachings of Ito and Bryborn which has not been overcome by any convincing arguments

from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of representative independent claim 1, as well as claims 3, 4, 6-11, 14, 16, 17, 19, and 20 not separately argued by Appellants, is sustained.

II. The obviousness rejections of claims 2, 5, 12, and 18.

We also sustain the Examiner's obviousness rejections of dependent claims 2, 5, 12, and 18 in which the Examiner has applied the Kannan and Ilan references in separate combinations with Ito and Bryborn to address the pointing device button and stroke parameter calculating features of the rejected claims. Appellant's arguments (App. Br. 16-18) rely on those previously made with respect to independent claim 10, which arguments we found to be unpersuasive as discussed *supra*.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have shown that the Examiner erred in rejecting claims 9-12 and 14 as being directed to non-statutory subject matter under 35 U.S.C. § 101, but have not shown that the Examiner erred in rejecting claims 1-12, 14, and 16-20 for obviousness under 35 U.S.C. § 103.

DECISION

The Examiner's rejection of claims 1-12, 14, and 16-20, all of the appealed claims, is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

tkl

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